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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,046	06/29/2001	Peter O. Vale	60001.51USU1	9307

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EXAMINER

PARTON, KEVIN S

ART UNIT PAPER NUMBER

2153

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/895,046	VALE, PETER O.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kevin Parton	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 12/06/2004 regarding claim 1 have been fully considered but they are not persuasive. Please see the following reasons and the grounds of rejection below.
2. On page 7, paragraph 1, the applicant argues that the reference to Dickelman fails to teach analysis of the characters prior to adding the prefix and suffix. The argument is not persuasive because the claims do not require this analysis as written. While the claim does require determination of a "single word," there is no definition of what constitutes a single word. The reference clearly shows in column 2, lines 50-56 that the presence of a single word ("phoneserver") is determined and the prefix and suffix are then added. The applicant points to the specification to state that "in a preferred embodiment" a single word would be defined as text entered without a period, once a period is entered, it is no longer considered a "single word" (specification page 9, lines 20-26). However, as shown, this is just a preferred embodiment and this limitation is not recited in the claim. The reference to Dickelman anticipates the claim.
3. Applicant's arguments regarding claim 15 have been considered but are moot in view of the new grounds of rejection shown below. Please note that the amendment to the claims required the new grounds of rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickelman (USPN 6,529,187).

6. Regarding claim 1, Dickelman (USPN 6,529,187) teaches a system for entering an address into a web browser of a mobile device with means for:

- a. Receiving at least one character of text (column 2, lines 51-56; column 4, lines 45-47).
- b. Determining whether the at least one character of text is a single word (column 4, lines 45-47).
- c. If so, then displaying a list in the web browser with a list item wherein the list item comprises the at least one character of text with an automatic prefix added before the at least one character of text and an automatic suffix added after the at least one character of text (column 4, lines 45-47; column 5, lines 55-60). Note that the claim allows for a list of one item which is shown in the reference.

7. Regarding claim 2, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 1. He further teaches means wherein the automatic prefix is "www." (column 4, lines 45-47).

8. Regarding claim 3, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 2. He further teaches means wherein the automatic suffix is ".com" (column 4, lines 45-47).

9. Regarding claim 4, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 1. He further teaches means wherein the mobile device is a wireless telephone (column 3, lines 13-16).

10. Regarding claim 11, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 1. He further teaches means wherein the at least one character of text is received in response to a user selecting keys on a keypad of a wireless phone (column 3, lines 12-15).

11. Regarding claim 12, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 1. He further teaches means wherein the automatic prefix and the automatic suffix may be modified to a desired prefix and a desired suffix (column 5, lines 61-65).

12. Regarding claim 13, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 12. He further teaches means wherein the automatic prefix and automatic suffix are modified by receiving input from a user requesting that the automatic prefix be set to a first string and that the automatic suffix be set to a second string (column 5, lines 61-65).

13. Regarding claim 14, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 13. He further teaches means wherein the automatic prefix and the automatic suffix are stored in a registry (column 4, lines 45-47).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5-10 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickelman (USPN 6,529,187) in view of Will (USPN 6,392,640).

16. Regarding claim 5, although the system disclosed by Dickelman (USPN 6,529,187) (as applied to claim 1) shows substantial features of the claimed invention, it fails to disclose means for determining whether the at least one character of text matches any previous addresses entered into the web browser; and if so, then displaying the possible matches as list items in the list.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will (USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a mobile device with means for determining whether the at least one character of text matches any previous addresses entered into the web browser (column 5, lines 22-23; abstract); and if so, then displaying the possible matches as list items in the list (column 6, lines 55-58). Note that in the reference, recently used addresses may be the type of words being searched.

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Dickelman (USPN 6,529,187) by employing the determination of a word corresponding to the characters entered. This benefits the system by increasing the ease with which a user can enter addresses into a mobile device.

17. Regarding claim 6, although the system disclosed by Dickelman (USPN 6,529,187) (as applied to claim 5) shows substantial features of the claimed invention, it fails to disclose means wherein the step of determining whether the at least one character of text matches any previous addresses entered into the web browser comprises searching the addresses of previously viewed URLs in the browser's history, cache, or recently entered addresses for potential matches.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will (USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a mobile device with means for searching the addresses of previously viewed URLs in the browser's history, cache, or recently entered addresses for potential matches (abstract; column 5, lines 22-23; column 6, lines 55-58).

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Dickelman (USPN 6,529,187) by employing the searching of recently viewed addresses

in creating the list. This benefits the system by presenting only items that are most likely to be of use to the user.

18. Regarding claim 7, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 5. He further teaches means for:

- a. Determining whether the user is ready to navigate to the URL defined by the at least one character of text (figure 1; column 4, lines 59-63; column 5, lines 20-22).
- b. If so, the navigating the web browser to display a page defined by the at least one character of text (column 6, lines 20-22).

19. Regarding claim 8, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 7. He further teaches means wherein the at least one character of text is displayed in an address field (column 4, lines 45-47).

20. Regarding claim 9, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 7. He further teaches means for:

- a. Determining whether one of the list items in the list has been selected by the user (figure 1; column 4, lines 59-63; column 5, lines 20-22).
- b. If so, then navigating the web browser to display a page located at an address defined by the selected list item (column 5, lines 20-22).

21. Regarding claim 10, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 9. He further teaches means wherein if one of the list items has not been selected by the user, then receiving another character of text (figure 1; column 4,



lines 59-63; column 5, lines 20-22). Note that the user enters the address before choosing to navigate there.

22. Regarding claim 15, Dickelman (USPN 6,529,187) teaches a system for text entry in an electronic device with means for:

- a. Receiving at least one character of text (column 2, lines 51-56; column 4, lines 45-47).
- b. Determining whether the at least one character of text is a single word and if so, then adding a prefix and a suffix to the at least one character of text to form a combined address and displaying the combined address as an entry in a selection list (column 4, lines 45-47; column 5, lines 55-60).
- c. Displaying the at least one address in the selection list (column 4, lines 45-47; column 5, lines 55-60).
- d. Receiving an input selecting the at least one address and navigating a web browser program module to view a web page located at the at least one address (figure 1; column 4, lines 59-63; column 5, lines 20-22).

Although the system disclosed by Dickelman (USPN 6,529,187) shows substantial features of the claimed invention, it fails to disclose means for:

- a. Searching a history folder in the electronic device to find at least one address with the at least one character of text.

- b. If the at least one character of text includes a period, then not adding a prefix and a suffix to the at least one character of text to form a combined address and not displaying the combined address as an entry in the selection list.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will (USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a mobile device with means for: searching a history folder in the electronic device to find at least one address with the at least one character of text (abstract; column 5, lines 22-23; column 6, lines 55-58; column 7, lines 10-12).

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Dickelman (USPN 6,529,187) by employing a search of a user's history to create a list. This benefits the system by only showing data that is most likely to be of use to the user instead of a very large list of all available words that match.

Further, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Dickelman (USPN 6,529,187) by not adding the prefix and suffix to a word if a period is entered. It would be obvious that if a person is entering a web address and entered a period, then the person is signifying that the full address is known and adding a prefix and suffix is unnecessary. This benefits the system by avoiding the placement of useless

information in the selection list such as full addresses with additional prefixes and suffixes.

23. Regarding claim 16, although the system disclosed by Dickelman (USPN 6,529,187) (as applied to claim 15) shows substantial features of the claimed invention, it fails to disclose means wherein the plurality of addresses comprises at least one address found by searching a memory location in the electronic device and to find the at least one address with the at least one character of text.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will (USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a mobile device wherein the plurality of addresses comprises at least one address found by searching a memory location in the electronic device and to find the at least one address with the at least one character of text (abstract; column 5, lines 22-23; column 6, lines 55-58).

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Dickelman (USPN 6,529,187) by employing the searching of recently viewed addresses in creating the list. This benefits the system by presenting only items that are most likely to be of use to the user.

24. Regarding claim 17, although the system disclosed by Dickelman (USPN 6,529,187) (as applied to claim 16) shows substantial features of the claimed invention,

it fails to disclose specifically means wherein the memory location is a history folder in a web browser program module of the electronic device.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Dickelman (USPN 6,529,187).

A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Dickelman (USPN 6,529,187) by searching the web browser history for recently viewed addresses. This benefits the system because the history folder is a common place where different types of web browsers store the web pages of recent interest to the user.

25. Regarding claim 18, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 15. He further teaches means wherein the selection list is a selection list in a web browser program module and the combined address and the plurality of addresses comprise URLs for Internet addresses (column 4, lines 45-47).

26. Regarding claim 19, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 18. He further teaches means for receiving an input selecting the at least one character of text and navigating the web browser program module to view a web page located at an address defined by the at least one character of text (column 6, lines 20-22).

27. Regarding claim 20, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 18. He further teaches means for receiving an input selecting the combined address and navigating the web browser program module to view a web page located at the combined address (column 6, lines 20-22).

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28. Regarding claim 21, Dickelman (USPN 6,529,187) teaches all the limitations as applied to claim 18. He further teaches means for receiving an input selecting an address and navigating the web browser program module to view a web page located at the address (column 6, lines 20-22).

Although the system disclosed by Dickelman (USPN 6,529,187) shows substantial features of the claimed invention, it fails to disclose means wherein the address is selected from a plurality of addresses.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Dickelman (USPN 6,529,187), as evidenced by Will (USPN 6,392,640).

In an analogous art, Will (USPN 6,392,640) discloses a system for entering data on a mobile device wherein the address is selected from a plurality of addresses (column 5, lines 22-23; abstract).

Given the teaching of Will (USPN 6,392,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Dickelman (USPN 6,529,187) by employing the selection from a plurality of addresses. This benefits the system by allowing a user to see multiple addresses that may be of interest that are similar to the entered character.

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see Ortega et al. (USPN 6,564,213).

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (571)272-3958. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

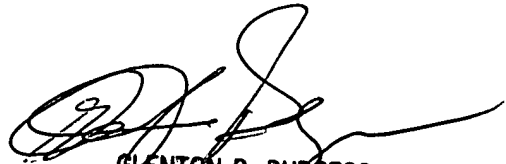
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton  
Examiner  
Art Unit 2153

ksp



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